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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

JACKSON, BRANDON LEE

ART UNIT

PAPER NUMBER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/823,585	Applicant(s) FU KONG ET AL.	
	Examiner BRANDON JACKSON	Art Unit 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 9/3/2008 have been fully considered but they are not persuasive. With respect to claims 1-7, 9-12, 14, and 19-20, Applicant argues that the lateralization effect of the Kurland device cannot be adjusted by changing the angular orientation. However, Applicant concedes that the angular orientation of Kurland's lateralization member can be adjusted and the claim 1 states the lateralization effect is altered by adjusting the angular orientation of the lateralization member. If the Kurland device has the same structural parts and is able to accomplish the same functional steps as set forth in the claims, then the device must be able to have the same intended use. Moreover, even if the lateralization effect of the Kurland device can be altered using a different method, that does not preclude it from anticipating another possible way the same device can be adjusted as long as the device is fully capable of it. Therefore, the Kurland device anticipates claims 1-7, 9-12, 14, and 19-20.

With respect to claims 8, 13, and 16-18, Applicant argues there would have been no motivation to modify the shape of the Kurland lateralization member with the shape of Kostich handgrip (144). However, the handgrip is shaped in an eccentric manner in order to better conform to the interior portion of a joint. Therefore, one would want the Kurland lateralization member to have the same type of shape for when it is used in the interior of an elbow or knee joint; and the opposite broader side, where the support is positioned could be used for joints like the under-arm or groin. Therefore, claims 8, 13, and 16-18 are obvious over Kurland in view of Kostich.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-12, 14, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kurland (US Patent 4,653,482). Kurland discloses a lateralization device (fig. 1) comprising a supporting member (32, 33, 34) adapted to be supported in a fixed position, a lateralization member (18, 31) mounted onto the supporting member (32, 33, 34) and extending laterally therefrom to provide a lateralization effect to a user's body portion, wherein the lateralization effect varies in different lateral directions via moving the lateralization device (fig. 1) along the lateral slot (19). The supporting member (32, 33, 34) comprises a post member (32), wherein the post member (32) comprises a substantially cylindrical outer wall. The post member (32) comprises a plurality of interference fittings (fig. 4) on the outer wall for engaging with complementary interference fittings (fig. 4) formed on an inner wall of the lateralization member (18, 31). The lateralization member (18, 31) is formed of a material that can resist pressure exerted thereon and maintain its initial shape during moral use. The lateralization member (18, 31) comprises a substantially cylindrical member (31) with a recessed portion (fig. 4) formed by an inner wall, wherein the cylindrical member (31) has a substantially circular cross-section. The lateralization member (18, 31) comprises a

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padding member (col. 2, lines 41-42) that wraps around the lateralization member (18, 31). The lateralization member (18, 31) can rotate relative to the supporting member (32, 33, 34). The lateralization member (18, 31) is fully capable of being used to provide lateralization to a user's hip joint during a hip arthroscopy. The supporting member (32, 33, 34) is adapted to be mounted onto a fracture table.

With respect to claims 19-20, Kurland discloses all the structural elements of the claimed invention; therefore, the method steps would have resulted from the use of the Kurland device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8, 13, and 16-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland (US Patent 4,653,482) in view of Kostich (US Patent 5,623,949). Kurland

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substantially discloses the claimed invention; see rejections to 1-7, 9-12, and 14 above. Kurland fails to disclose the recessed portion is located in an eccentric position on the cylindrical member. However, Kostich teaches a positioning device (110) comprising eccentric cylindrical members (144). Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the lateralization member of Kurland to have the shape, as taught by Kostich, in order to better receive body parts and provide the user with more comfort. The eccentric nature of the Kurland/Kostich lateralization member would cause a change in the angular orientation of the lateralization member when rotated about the threaded support post. Rotating the lateralization member of Kurland/Kostich would allow the user to adjust lateralization member, which in turn would alter the lateralization effect.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland (US Patent 4,653,482) in view of Spetzler et al. (US Patent 6,805,453). Kurland substantially discloses the claimed invention; see rejection to claim 1 above. Spetzler teaches a medical device (100) comprising a drape (110) to cover the device (100). Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the Miller device to have a drape covering the lateralization device, as taught by Spetzler, in order to keep the device sterile after usage.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland (US Patent 4,653,482) in view of Roberts et al. (US Patent 6,385,802). Kurland

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substantially discloses the claimed invention; see rejection to claim 1 above. Moreover, Kurland discloses a rigid supporting member (32, 33, 34) surrounded by a padded lateralization member (18, 31). Kurland fails to disclose the lateralization member is expandable in a lateral direction. However, operating room table (10) comprising a positioning member (fig. 2); wherein the positioning member comprises a rigid support (56) surrounded by a block material (54) subsequently wrapped in a chamber (52) containing an inflatable bladder (40) padding (48). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Kurland lateralization member to have an outer encasement (46), as taught by Roberts, in order to more precisely adjust the lateralization member for size and procedures of different patients.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland/Kostich as applied to claim 16 above, and further in view of Roberts et al. (US Patent 6,385,802). Kurland/Kostich substantially discloses the claimed invention; see rejection to claim 1 above. Moreover, Kurland/Kostich discloses a rigid supporting member (32, 33, 34) surrounded by a padded lateralization member (18, 31). Kurland/Kostich fails to disclose the lateralization member is expandable in a lateral direction. However, operating room table (10) comprising a positioning member (fig. 2); wherein the positioning member comprises a rigid support (56) surrounded by a block material (54) subsequently wrapped in a chamber (52) containing an inflatable bladder (40) padding (48). Therefore, it would have been obvious to one of ordinary skill in the

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art at the time of the invention to modify the Kurland/Kostich lateralization member to have an outer encasement (46), as taught by Roberts, in order to more precisely adjust the lateralization member for size and procedures of different patients.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDON JACKSON whose telephone number is (571)272-3414. The examiner can normally be reached on Monday - Friday 8-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571)272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brandon Jackson/
Examiner, Art Unit 3772

BLJ

/Patricia Bianco/
Supervisory Patent Examiner, Art Unit 3772